

Appln No. 10/735,147
Amdt date August 8, 2006
Reply to Office action of May 10, 2006

REMARKS/ARGUMENTS

Claims 1-25 remain in the present application, of which claims 1 and 14 are independent. Claims 1 and 14 have been amended herein. None of the claims is cancelled. Applicants request reconsideration and allowance of claims 1-25.

I. Telephone Interview

Applicants thank the Examiner for the time and courtesy extended to Applicants' attorney during the telephone interview of July 5, 2006. During the telephone interview, claims 1 and 14 were discussed in reference to U.S. Patent No. 5,853,290 ("Winston") and U.S. Patent No. 6,086,369 ("Sharp et al."). No agreement was reached as to the patentability of any of the claims. However, the Examiner and Applicants' attorney agreed that the art of record does not show "at least one O-ring for shock absorption, mounted on the connecting body around the engagement portion in the vicinity of a location where the tip engages the engagement portion."

II. Rejection of Claims 1-25 under 35 U.S.C. § 103(a)

Rejection of Claims 1-12 and 14-25

Claims 1-12, 14-25 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Sharp et al. in view of Winston. In rejecting these claims, the Examiner contends that Sharp discloses "an ultrasonic dental insert for an ultrasonic dental tool comprising a transducer 20 for generating ultrasonic vibrations, a connecting body 18 having a proximal end and a distal end, the proximal end attached to the transducer, the distal end having an engagement portion formed thereon, a handgrip 22 enveloping at least a portion of the connecting body, at least one O-ring 34, for sealing, mounted between the connecting body and the hand grip." The Examiner further contends that "[d]ue to the nature of the material (it must be somewhat flexible and compressible) the O-ring would inherently provide shock absorption between the connecting body and the handgrip. An O-ring 35 is mounted on the connecting

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body and around the engagement portion and provides shock absorption (column 4, lines 60-64)."

While the Examiner concedes that "Sharp does not teach that the tip is made of plastic," the Examiner further contends that "[i]t would have been obvious to one of ordinary skill in the art at the time the invention was made to make the tips of Sharp out of plastic, in view of Winston, so that the tips may be cheaply interchangeable and disposable."

In order to establish a *prima facie* case of obviousness, however, the following three criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference. Second, there must be a reasonable expectation of success. Finally, the prior art reference, or combination of references, must teach or suggest all the claim limitations. See MPEP § 2142.

Each of claims 1 and 14 now recites, in a relevant portion, "at least one O-ring for shock absorption, mounted on the connecting body and around the engagement portion in the vicinity of a location where the tip engages the engagement portion." (Emphasis Added). As Applicants' attorney discussed with the Examiner during the July 5, 2006 telephone interview, neither Sharp et al. nor Winston teaches or suggests this limitation. Therefore, a *prima facie* case of obviousness cannot be established for claims 1 and 14 over Sharp et al. in view of Winston, and claims 1 and 14 would not have been obvious over Sharp et al. nor Winston at the time that the invention was made. Therefore, Applicants respectfully request that the rejection of claims 1 and 14 be withdrawn and that they be allowed.

Since claims 2-12 and 15-25 depend, directly or indirectly, from claim 1 or claim 14, these claims each incorporate all the terms and limitations of claim 1 or claim 14 in addition to other limitations, which together further patentably distinguish these claims over the cited references. Therefore, Applicants request that the rejection of claims 2-12 and 15-25 be withdrawn and that these claims be allowed.

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Rejection of Claim 13

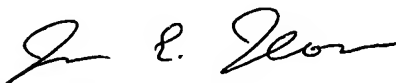
Claim 13 was rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Sharp et al. in view of Winston as applied to claim 1 above, and further in view of U.S. Patent No. 4,589,847 ("Loge et al."). Loge et al. is being cited here for the proposition that it discloses "an ultrasonic dental handpiece comprising a hand grip 1 having a plurality of bumps formed on the outer surface." However, Loge et al. does not cure the deficiencies of Sharp et al. and Winston to reject claim 1. Therefore, claim 1 is patentably distinguishable over Sharp et al. in view of Winston and Loge et al.

Since claim 13 depends from claim 1, claim 13 incorporates all the terms and limitations of claim 1 in addition to other limitations, which together further patentably distinguish claim 13 over the cited references. Therefore, Applicants request that the rejection of claim 13 be withdrawn and that this claim be allowed.

III. Concluding Remarks

In view of the foregoing amendments and remarks, Applicants earnestly solicit an early issuance of a Notice of Allowance with claims 1-25. If there are any remaining issues that can be addressed over the telephone, the Examiner is cordially invited to call Applicants' attorney at the number listed below.

Respectfully submitted,
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